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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,187	01/21/2004	James Kenneth Taillon	0214.007C	3673

7590 05/08/2007
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EXAMINER

PRASAD, CHANDRIKA

ART UNIT	PAPER NUMBER
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2839

MAIL DATE	DELIVERY MODE
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05/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,187

Applicant(s)

TAILLON ET AL.

Examiner

Chandrika Prasad

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 9-16, 19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 9-16, 19, 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The error is not specific enough under MPEP section 1414(II)(C). MPEP 1414 (II)(C) states that "(a)ny error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error." It further states that "(a) statement of "failure to include a claim directed to ..." and then presenting a newly added claim would not be considered a sufficient "error" statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or vica-versa. Applicant has failed to identify the specific claim language wherein lies the error and basically does not state any error. Applicant just states that "prior art not previously known to the assignee or inventors was discussed in an interference proceeding. Accordingly, this reissue application adds additional claims that are narrower than the original patent claims." Applicant does not state what the prior art was and, more specifically, that any specific prior art rendered any specific claim of the patent (i.e., the patent upon which this reissue application is based) unpatentable.

2. Claims 2-4, 9-16,19 and 21-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 2-4, 9-16, 19 and 21-28 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. claims.

This reissue application purports to be a narrowing reissue application but it is not. The new claims in the reissue application are broadening reissue claims under MPEP section 1412.03 (I) which makes this a broadening reissue which would have needed to be filed within 2 years of the issue date of the patent (see 35 USC 251 and MPEP section 1412.03 (IV)) and would have required a declaration signed by the inventors (see MPEP section 1412.03(V)).

The independent claim of the patent was a method claim which included the method step of "matably connecting said first member (a sleeve in the reissue claims) to said second member (a clip in the reissue claims) such that said first member and said second member define a hollow inner chamber ..." The new claims added in the reissue only requires "a clip having a hollow inner chamber therein." There is no requirement in the newly added claims that a hollow chamber is defined after the clip and sleeve are mated together. Thus, the newly added claims are broader than the patent claims under the provisions of MPEP section 1412.03 (I).

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

The standard for broadening if a claim is broadening is if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.

4. The amendment filed on 6/14/04 is in improper format under 37 CFR 1.173(d) in that it uses strike-throughs instead of brackets to indicate the subject matter to be omitted by reissue.


Contact Information

5. Any correspondence to this action may be mailed to:

**Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad whose telephone number is (571) 272-2099.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (571) 272-2800 ext 39. The fax number is (703) 872-9306.


Chandrika Prasad
Primary examiner
May 02, 2007